

IN THE U.S. PATENT AND TRADEMARK OFFICE BEFORE
THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re patent application of

Jean-Francois BACH *et al.*

Serial No. 08/986,568

Group Art Unit: 1644

Filed: December 5, 1997

Examiner: G. Ewoldt

For: *METHOD FOR TREATING ESTABLISHED SPONTANEOUS
AUTO- IMMUNE DISEASES IN MAMMALS*

REQUEST FOR CLARIFICATION

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This communication relates to a Decision on Appeal, mailed in the above-captioned case on January 9, 2002.

On appeal the Board reversed the examiner's rationale for rejection but imposed new grounds for rejecting a single claim. While reversing an obviousness rejection of all appealed claims, based on the combination of *Racadot et al.*, *Gussow et al.* and *Chatenoud et al.*, the Board enunciated a new lack-of-novelty rejection of claim 1, based upon *Chatenoud et al.* Thus, only the Section 102 rejection of claim 1 is pending.

In this regard, the Board decided that claims 2, 4-7, 9-13 and 16-18 "fall together with claim 1" because appellants had "grouped the claims as standing or falling together." Decision at page 7, lines 1-3. Because the pending rejection was raised for the first time by the Board, however, appellants could not have grouped the claims in light of the new grounds for rejection.

Since the Board's rejection is new, appellants seek clarification as to whether the previous claim grouping remains in force.

Respectfully submitted,

7 March 2002

Date

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